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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/806,267	03/23/2004	Takashi Ohno	KKP-0276	1916
23353 7590 07/02/2007 RADER FISHMAN & GRAUER PLLC LION BUILDING 1233 20TH STREET N.W., SUITE 501 WASHINGTON, DC 20036			EXAMINER YOON, TAE H	
			ART UNIT 1714	PAPER NUMBER
			MAIL DATE 07/02/2007	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/806,267	Applicant(s) OHNO, TAKASHI	
	Examiner Tae H. Yoon	Art Unit 1714	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 09 April 2007 and 12 April 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-6,8,9,11 and 13 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-6,8,9,11 and 13 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 23 March 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

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Notes new examiner.

The product brochure for JONCRYL supports Mw of claim 4. Also, the recited "formed by" in claim 5 would be further limitation of the recited "consisting essentially of" in claim 1 since said "formed by" means "consisting of" since only water and alcohol are recited (with respect to comment made by the former examiner in the advisory action).

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1-6, 8, 9, 11 and 13 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

This is NEW MATTER rejection since the recited "to 13 kPa" in line 6 of claim 1 does not have support in originally filed specification. Applicant states various vapor pressures for alcohol in response without providing any supporting document thereof. Also, a vapor pressure of 12.8 kPa for methanol does not support the instant 13 kPa.

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct

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from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-6, 8, 9 and 13 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 15-18 of copending Application No. 11/105,550 (Pub. No.: US 2005/0239919 A1). Although the conflicting claims are not identical, they are not patentably distinct from each other because the ink of said application inherently contains the instant ink as evidenced by examples.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-6, 8, 9, 11 and 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ota et al (US 6,916,862) in view of JP 2000043465 A and Kanbayashi et al (US 6,114,412), and further in view of Kobayashi et al (US 5,678,942) and Hattori et al (US 2005/0096410 A1).

Ota et al, Hattori et al, Kanbayashi et al and Kobayashi et al are discussed in previous office actions.

Now, claims recites a ballpoint pen comprising the recited ink composition and stainless steel ball point tip having a surface roughness of 5 nm or less over Ota et al, Hattori et al, Kanbayashi et al and Kobayashi et al.

However, JP teaches a ballpoint pen using a ball having an arithmetic mean surface roughness of 0.004-0.010 μm (4-10 nm) in abstract.

Thus, it would have been obvious to one skilled in the art at the time of invention to make a ballpoint pen comprising the ink of Ota et al containing a phosphate ester surfactant of Kanbayashi et al in order to prevent rusting of the tip of ball point pen with a ball having an arithmetic mean surface roughness of 4-10 nm of JP in Ota et al and Kanbayashi et al thereof, and further to make a ballpoint having the instant structure as taught by Kobayashi et al in Ota et al thereof since Ota et al teach use of the ink in a ballpoint pen, and Hattori et al teach the instant vapor pressure absent showing otherwise.

Applicant's argument and 1.132 declaration have been considered, but they failed to overcome the rejection for following reasons;

1. Claims 1-6, 8, 9 and 13 do not require writing on a non-permeable writing surface since the claimed ballpoint can be used to write on a regular paper inherently porous by a consumer such as a student. Thus, showing in said declaration has little probative value.

2. For claim 11, the recited ink composition in claim 1 comprises water, alcohol, pigment, phosphate ester surfactant and water-soluble resin. However, examples 1, 3, 5 and 6 used in said declaration contain additional components not recited in the instant claims. Said additional components include (now cancelled) silicone wetting regulating agent, and additional water-soluble resin. Furthermore, amounts of components used in said examples are narrow in scope with respect to the claimed composition, thus, even though said showing in the declaration has some probative value, the scope of claim is broader than such showing.

3. Applicant asserts that examples of Ota et al is directed to an inkjet even though Ota et al mention a ballpoint pen, but, see *In re Mills*, 477 F2d 649, 176 USPQ 196 (CCPA 1972); Reference must be considered for all that it discloses and must not be limited to its preferred embodiments or working examples. Thus, utilization of the ink obtained by Ota et al and Kanbayashi et al in a ballpoint pen structure of JP and/or Kobayashi et al would be a *prima facie* obviousness.

4. Applicant further asserts that Ota et al failed to disclose a solvent comprising both water and alcohol, but such assertion has no probative value since Ota et al clearly teach a solvent comprising both water and alcohol in examples 7 and 8 (cols. 40 and

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41), for example. Also, said examples 7 and 8 show the instant amounts in claims 2, 5 and 6.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tae H. Yoon whose telephone number is (571) 272-1128. The examiner can normally be reached on Mon-Thu.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vasu Jagannathan can be reached on (571) 272-1119. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



Tae H Yoon
Primary Examiner
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THY/June 25, 2007